UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,439	04/10/2001	Craig E. Columbus	26119.120US1	8762

28089 7590 11/03/2006

WILMER CUTLER PICKERING HALE AND DORR LLP
399 PARK AVENUE
NEW YORK, NY 10022

EXAMINER	
KESACK, DANIEL	

ART UNIT	PAPER NUMBER
3691	

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/829,439	COLUMBUS ET AL.	
	Examiner	Art Unit	
	Dan Kesack	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-77* is/are pending in the application.

4a) Of the above claim(s) *1-17,29-37,45-52,60-64,68-72 and 76* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-28,38-44,53-59,65-67,73-75 and 77* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/14/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This application has been reviewed. Original claims 1-77 are currently pending. The rejections are as stated below.

Election/Restrictions

2. Applicant's election of Group II in the reply filed on August 21, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-17, 29-37, 45-52, 60-64, 68-72 and 76 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18, 19, 23, 38, 53, 65, 73, and 77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18, 38, 53, 65, 73, 77, recite the step "utilizing information pertaining to at least one upward or downward revision including an upward or downward change in opinion of the analyst with regard to the at least one investment;" The claim language is not sufficiently clear for one of ordinary skill in the art to know what is considered an "upward or downward revision," according to the current invention. Furthermore, it is not clear whether the "revision" must necessarily include an upward or downward change in opinion, or if the information pertains to the revision *and* includes an upward or downward change in opinion.

Claims 18, 38, 53, 65, 73, 77, further recite "calculating a performance score... determined at least in part by considering... [non-pertinent modifiers omitted]" The word "considering" renders the claim indefinite because "considering" does not clearly define that the subsequently listed measurements are used at all in the calculation, but only requires that they are "considered" which could be interpreted as merely contemplating their use. Therefore, it is not clear how the performance score is calculated, or what elements are used in their calculation.

Claims 18, 38, 53, 65, 73, 77 further recite one measurement that is considered in the calculation as being "a standard deviation of the at least one upward or downward revision." This renders the claim indefinite because a standard deviation requires that

the "revision" be numerical, while above, the claim recites the revision includes a change of opinion. For example, in the event the revision is a change in recommendation from "hold" to "sell", as may be interpreted by the claim language, it is unclear how the standard deviation would be computed.

Claim 19 recites "said three distinct periods of time." There is insufficient antecedent basis for this phrase in the claims from which claim 19 depends.

Claim 19 recites approximately five days, approximately twenty days, and approximately sixty days. The word approximately is indefinite because it does not clearly establish the metes and bounds of the patent protection desired.

Claim 23, the modifier "small" is a relative term, and does not clearly define the return penalty.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-28, 38-44, 53-59, 65-67, 73-75, and 77 rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Specifically, in claims 18, 38, 53,

65, 73, and 77, the claimed invention as a whole does not accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." See State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention. The mere fact that the claim recites, "comparing the analyst's performance score against performance scores of other analysts" does not satisfy the requirement of 35 U.S.C. 101. The claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore is non-statutory under 35 U.S.C. § 101. Examiner respectfully points out that the claim does not require the step of producing the revision ranking, and the phrase "to produce at least one upward, downward, or combined revision ranking" is interpreted as intended use of the comparing step, and therefore is generally not considered for patentability. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 18-28, 38-44, 53-59, 65-67, 73-75, and 77 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 7,016,872. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards steps for calculating a performance score, and ranking analysts according to said performance

score. As recited, the data used in the current application pertains to an upward or downward revision including a change in opinion of the analyst, whereas patented claims utilize data pertaining to transactions made by an investor. Examiner notes that it would be obvious to substitute analyst with investor in the current application because an investor would have an opinion with regard to investments, considering the investor's vested interest in the investment, and therefore could be considered an analyst. Examiner has also interpreted the "transaction" of the patented claims to be a "change of opinion of the analyst." As such, an investor participating in a transaction is inherently an analyst changing his or her opinion with regard to an investment about whether or not he or she will partake in the transaction. The present application incorporates by reference, the application of Patent No. 7,016,872, which describes the utilization of data pertaining to investors involved in transactions, and provides further enablement for this interpretation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

***

HANI M. KAZIMI
PRIMARY EXAMINER